

Remarks

Introduction

Claims 1-43 remain pending. By way of this response, claims, 1, 11, and 31 have been amended. Support for the amendments to the claims can be found in the specification as originally filed. In view of the amendments to the claims and the remarks herein, applicant respectfully requests reconsideration and withdrawal of each of the claim rejections.

Rejections Under 35 U.S.C. § 102

Claims 1-4, 7-9, 11-15, 17-21, 31-34, and 36-41 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Lieberman (U.S. Pat. No. 5,880,809). Claims 11-15 and 17 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Townsley (U.S. Pat. No. 5,020,898).

Applicant traverses each of these rejections as it relates to the present claims.

Lieberman discloses soft, hard, or gas-permeable contact lenses. Lieberman specifically discloses that the lenses can be made from hydrophilic polymers, poly(methylmethacrylate), or rigid gas-permeable polymeric materials. Lieberman states that the rigid gas-permeable polymeric materials include fluoro-silicone acrylate, flexible fluoro polymers, siloxane acrylate, styrisilicone, 1-butyl styrene/silicone acrylate, polysulfone-fluoro silicone acrylate, and fluoropolymer (see column 15, lines 52-62).

Lieberman does not disclose, teach, or suggest the present invention. For example, Lieberman does not disclose, teach, or even suggest, a contact lens that includes a water absorbing lens body including a silicone hydrogel, as recited in independent claim 1, or a water absorbing lens body including a hydrophilic silicone polymer component, as recited in independent claims 11 and 31.

Applicant notes that the Examiner relies on column 15, lines 52-62 of Lieberman for the disclosure of silicone hydrogel containing contact lenses. As identified above, applicant submits that Lieberman does not disclose, teach, or even suggest a silicone hydrogel. Applicant submits that the disclosure of Lieberman that includes the word "silicone" is a description of different rigid gas-permeable contact lenses. As understood by persons of ordinary skill in the art, rigid gas-permeable contact lenses, and silicone hydrogel contact lenses or hydrophilic silicone polymer containing contact lenses are different and distinct, one from the other. For example, rigid gas-permeable contact lenses do not absorb water.

The presently claimed lenses comprise a lens body which includes a silicone hydrogel (claim 1) or a hydrophilic silicone polymer component (claims 11 and 31). The presently claimed lenses therefore absorb water and can be water swellable. Thus, the presently claimed contact lenses are not disclosed, taught, or suggested by Lieberman.

Townsley discloses contact lenses that can be formed of materials such as hydroxyethylmethacrylate, metalloorganic substances, silicone rubbers, and materials described in U.S.

Pat. Nos. 3,503,942 and 3,639,524. Townsley further states that the preferred soft contact lenses are hydrophilic, and that the contact lenses disclosed in U.S. Pat. No. 4,405,773 are especially preferred (column 1, lines 43-53).

Townsley does not disclose, teach, or suggest the present invention. For example, Townsley does not disclose, teach, or even suggest a lens body of a contact lens including a hydrophilic silicone polymer component, as recited in independent claim 11.

The only reference of a silicone material for the contact lenses disclosed by Townsley is to silicone rubber contact lenses. Silicone rubber contact lenses and hydrophilic silicone polymer containing lenses are different and distinct, one from the other. As understood by persons of ordinary skill in the art, silicone rubber contact lenses do not include a hydrophilic component, such as a hydrophilic silicone polymer component. In contrast to the presently claimed contact lenses, silicone rubber contact lenses have lens surfaces that are extremely hydrophobic. The hydrophobic characteristics of silicone rubber contact lenses can lead to such contact lenses disadvantageously binding to the surface of an eye.

The contact lens of claim 11 comprises a lens body which includes a hydrophilic silicone polymer component. In other words, the contact lens have some degree of hydrophilicity and, unlike silicone rubber contact lenses disclosed by Townsley, are not extremely hydrophobic. Thus, claim 11 is not disclosed, taught, or suggested by Townsley.

In view of the above, applicant submits that the present claims, and claims 1-4, 7-9, 11-15, 17-21, 31-34, and 36-41 in particular, are not anticipated by Lieberman or Townsley under 35 U.S.C. § 102.

Rejections Under 35 U.S.C. § 103

Claims 5-6, 16, 23-29, 35, and 42 have been rejected under 35 U.S.C. § 103(a) as being obvious over Lieberman. Claims 10, 22, 30, and 43 have been rejected under 35 U.S.C. § 103(a) as being obvious over Lieberman in view of Roffman (U.S. Pat. No. 6,554,425).

Applicant traverses each of these rejections as they relate to the present claims.

The Examiner takes Judicial Notice that it is well known in the art of contact lenses for contact lenses to have a varied anterior and/or posterior surface defining a ballast for the purpose of providing improved lens stability on the eye. The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to modify the contact lens of Lieberman to have a varied anterior and/or posterior surface defining a ballast since such a structure is well known in the art and is further taught by Lieberman with respect to prior art lenses for the purpose of providing a lens of improved stability on the eye.

Applicant submits that the present claims are unobvious from and patentable over Lieberman, taken alone or in combination with Roffman or the other cited references, since

Lieberman, taken alone or in combination with the other references, does not disclose, teach, or suggest all of the elements recited in the present claims.

For example, Lieberman does not disclose, teach, or even suggest a contact lens comprising a lens body which includes a silicone hydrogel or a hydrophilic silicone polymer component, as recited in certain of the present claims, and as discussed above. As discussed above, Lieberman specifically states that the lenses may include hydrophilic polymers, poly(methylmethacrylate), or rigid gas-permeable polymeric materials. In effect, Lieberman has specifically excluded silicone hydrogels or hydrophilic silicone polymer components. Applicant submits that Lieberman actually teaches away from the present claims since the only silicone-containing materials disclosed by Lieberman do not absorb water. Thus, Lieberman does not disclose, teach, or even suggest all of the elements of the present claims, such as claims 1, 11, and 31.

Townsley fails to resolve the deficiencies of Lieberman, as discussed above. For example, Townsley does not disclose, teach, or even suggest a contact lens comprising a lens body that includes a hydrophilic silicone polymer component, as recited in certain of the present claims. Townsley actually teaches away from the present claims since the only silicone containing material disclosed by Townsley is water impermeable and has hydrophobic surfaces.

Roffman fails to provide the deficiencies apparent in Lieberman. For example, Roffman only states that the contact

lenses may be either hard or soft lenses, and that soft contact lens materials are preferably used (column 4, lines 56-58).

Roffman does not disclose, teach, or even suggest a contact lens comprising a lens body that includes a silicone hydrogel or a hydrophilic silicone polymer component, as recited in certain of the present claims.

Thus, since Lieberman, taken alone or in combination with the other cited references, does not disclose, teach, or suggest each of the elements as recited in the present claims, applicant submits that the present claims are unobvious from, and patentable over Lieberman, taken alone or in combination with the other references, including Roffman.

In addition, with regard to claims that include a varied anterior and/or posterior surface defining a ballast, applicant submits that a person of ordinary skill in the art would not be motivated to modify the teachings of Lieberman to include a ballast.

The contact lens disclosed by Lieberman is aligned on an eye by matching the posterior surface of the contact lens to the contour of the cornea of an eye. Specifically,

The asymmetric aspheric posterior surface or surface portion of the contact lens of the present invention, which matches the asymmetric aspheric contour of the cornea, enables the lens to sit much more securely on the cornea, and rotate less with respect to the cornea, than any lens of the prior art (column 14, lines 62-67).

Applicant submits that Lieberman actually teaches away from contact lenses which comprise a ballast. For example, Lieberman specifically states that

In the lens of the present invention, the custom asymmetric contour of the lens will cause the lens to stay centered on the cornea, without the need for a ballast to orient the lens through the operation of gravity. (column 15, lines 13-16).

"As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994)).

Applicant submits that a person of ordinary skill in the art would not be motivated to modify the contact lens of Lieberman to include a ballast, since the contact lens of Lieberman already achieves the desired positioning and alignment without a ballast. Since Lieberman discloses a lens that achieves a desired alignment without a ballast, a person of ordinary skill in the art would not be motivated to add a ballast to the contact lens of Lieberman to provide contact lens alignment.

In addition, applicant submits that a person of ordinary skill in the art would not be motivated to combine the teachings of Lieberman and Roffman, as proposed by the Examiner. Roffman discloses rotationally symmetric contact lenses that are configured to correct a wavefront aberration of a patient's eye. Lieberman discloses asymmetric aspheric contact lenses that have surfaces precisely formed to align on a cornea based on the cornea's topography. Applicant submits that modifying the

contact lenses of Lieberman to include wavefront aberration correction as disclosed by Roffman would also require that the contact lenses of Lieberman be modified to be rotationally symmetric and spherical. Because Lieberman specifically teaches away from rotationally symmetric spherical contact lenses, applicant submits that a person of ordinary skill in the art would not be motivated to combine Lieberman and Roffman.

It is well established that a reference must be interpreted as a whole, and cannot be picked apart to deprecate an invention (*In re Fine*, 837 F.2d 1071, 1075, (Fed. Cir. 1988)). Applicant submits that when Lieberman and Roffman are considered in their entirety, a person of ordinary skill in the art would not be motivated to combine their teachings since Lieberman is directed to asymmetric aspherical contact lenses, and Roffman, to the contrary, is directed to symmetric rotationally spherical contact lenses.

In view of the above, applicant submits that the present claims, and claims 5-6, 10, 16, 22-30, 35, 42, and 43 in particular, are unobvious from and patentable over Lieberman, taken alone or in combination with Roffman, under 35 U.S.C. § 103.

In addition, each of the other present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present contact lenses including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

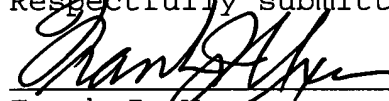
Conclusion

In conclusion, applicant has shown that the present claims are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore, applicant submits that the present claims, that is claims 1-43 are allowable. Therefore, applicant respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: _____

4/13/05

Respectfully submitted,



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